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Patent and Trademark Office**

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09/189,609 11/10/98 LIN

J 98-5295

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EXAMINER

NGUYEN, D

ART UNIT

PAPER NUMBER

3738

DATE MAILED:

07/21/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/189,609**

Applicant(s)  
**Lin**

Examiner  
**Dinh Nguyen**

Group Art Unit  
**3738**



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-24 is/are pending in the application.

Of the above, claim(s) 12-24 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-11 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3738

## **DETAILED ACTION**

### ***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-11 and 23-24, drawn to a method for treating presbyopia, classified in class 606, subclass 5.
- II. Claims 12-22, drawn to a method for preventing corneal tissue bleeding, classified in class 606, subclass 40.

- I. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are usable for different applications. The method of preventing bleeding may be used for any damage to the eye instead of visual correction.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention:

Art Unit: 3738

Species 1: claims 1-11 drawn toward a method for treating presbyopia not using a knife;  
and

Species II: claims 23-24 drawn toward a method for treating presbyopia using a knife.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Art Unit: 3738

During a telephone conversation with Mr. William Hobby, III on July 20, 2000 a provisional election was made with traverse to prosecute the invention of Group I - Species 1, claims 1-11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-24 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### *Specification*

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because at line 8 of the abstract, "The preferred embodiments of the present invention" is a legal phraseology and must be removed.

Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because of the following informalities:

The following appears to be misspellings: "mussel" at line 23 of page 3 and at line 8 of page 4.

Art Unit: 3738

At line 26 of page 8, item number 13 is described as the ciliary body and item 14 as the sclera. This appears to be reversed according to the labeling in the figures.

Appropriate correction is required.

### *Claim Objections*

Claims 7 and 11 are objected to because of the following informalities: In claim 7, at line 2, "6g" is a typographical error and should be removed. In claim 11, at line 5, "on" is a misspelling and should be changed to --one--. Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2 and 4-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruiz, USPN 5,533,997 in view of Smith, USPN 5,490,849. Ruiz discloses a laser beam ophthalmological surgical method for treating presbyopia using a scanning mechanism and laser beam. See column 1, lines 60-62; column 5, lines 20-24 and figures 1-2. Ruiz does not disclose a beam spot controller nor the predetermined laser wavelength and energy. However, Smith teaches using a beam spot controller with a predetermined laser wavelength and energy in order

Art Unit: 3738

to further refine the ablation process. See column 1, lines 40-63 and column 4, lines 45-50. It would have been obvious to one of ordinary skill in the art to have combined the teaching of using a beam spot controller with a predetermined laser wavelength and energy, as taught by Smith, to the method of treating presbyopia of Ruiz, in order to refine the ablation process.

Regarding claims 2 and 6, see the Smith citation above.

Regarding claim 10, since Smith discloses the claimed wavelength and energy, the coagulation process is inherent within the disclosed method.

Regarding claims 8 and 9, see the Ruiz citation above.

Regarding claims 4, 5, 11, the prior art does not disclose the specific pulse duration and metal mask (a polymeric mask was disclosed). Absent a showing of criticality, these features are considered design choices or because the pulse duration is dependent upon the amount of ablation needed for individual patient.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ruiz in view of Smith as applied to claim 1 above, and further in view of Bille et al., USPN 4,907,586.

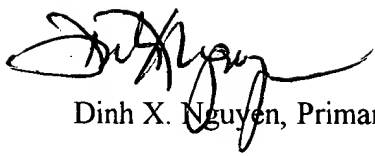
Neither Ruiz nor Smith discloses the specific wavelength as claimed. However, Bille teaches this specific wavelength for optimization of the ablation process. See column 2, lines 58-61 for example. It would have been obvious to one of ordinary skill in the art to have combined the teaching of using the specific wavelength as claimed, to the modified method of Ruiz and Smith, in order to optimize the ablation process.

Application/Control Number: 09/189,609

Page 7

Art Unit: 3738

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dinh X. Nguyen whose telephone number is (703) 305-3522.

A handwritten signature in black ink, appearing to read 'Dinh X. Nguyen', with a stylized, flowing script.

Dinh X. Nguyen, Primary Examiner

July 20, 2000